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**OFFICE OF PETITIONS**

In re Application	:
Chen et al.	:
Application No. 09/716,029	: DECISION ON APPLICATION
Filed: November 17, 2000	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 6200-0013	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed November 20, 2002. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) to thirty-eight (38) days.

The application for patent term adjustment is **DISMISSED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **ZERO (0) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 20, 2002, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On February 4, 2004, Applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is thirty-eight (38) days.

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<sup>1</sup> Applicants' submission of the issue fee and the PTA were made timely by including a Certificate of Mailing under 37 C.F.R. § 1.8 dated November 20, 2002.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for applicant delay of seventy-five (75) days pursuant to 35 U.S.C. 154(b)(1)(C)(ii) and 37 C.F.R. § 1.704(b). A non-final Office action was mailed on July 24, 2001. Applicants did not file an Amendment until January 7, 2002. The Office then mailed a Restriction Requirement on April 3, 2002.

Applicants assert entitlement to a patent term adjustment of thirty-eight (38) days on the basis that applicants timely responded to a July 24, 2001 non-final Office action with an Amendment bearing a Certificate of Mailing under 37 C.F.R. § 1.8 dated October 24, 2001. Accordingly, applicants argue that no applicant delay should have been assessed. Furthermore, applicants assert that PTO delay of 38 days should have been assessed because the Office did not respond to the October 24, 2001 Amendment until the Restriction Requirement was mailed on April 3, 2002.

If a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), and the applicant is otherwise entitled to patent term adjustment (or additional patent term adjustment) but for the fact that there was a reduction of such patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) due to the receipt of such reply by the Office more than three business days after the date indicated on the certificate of mailing, the Office will consider the USPS mail situation discussed in this notice to constitute a sufficient showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice. In this situation, the Office will, subject to the conditions set forth below, reinstate a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of

three months.<sup>2</sup>

In view of the above, the amendment with the Certificate of Mailing dated October 24, 2001, will be considered to have been filed in the Office four business days later, or October 30, 2001.<sup>3</sup>

Accordingly, Office delay should have been assessed at thirty-four (34) days, representing the period of delay from March 1, 2002 (four months after the date the reply was filed) until April 3, 2002.

However, Applicants should have been assessed delay of eighty-five (85) days pursuant to 37 C.F.R. 1.704(c)(8) for the filing of a supplemental reply or other paper (a supplemental amendment) on August 8, 2002, when Applicants previously filed a response to the April 3, 2002 Office action on May 15, 2002.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0)** (34 days of PTO delay, reduced by 85 days of applicant delay).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

*Karen Ferriter*

Karen Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
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<sup>2</sup> Processing of, and Requirements for, the Filing of Duplicate Applications and Papers in Patent Applications in view of USPS Mail Delays, 1254 Off. Gazette 92 (Jan. 15, 2002).

<sup>3</sup> October 27, 2001 and October 28, 2001 fell on a Saturday and Sunday, respectively.